

**Remarks**

This Amendment is responsive to the October 3, 2005 Final Office Action.  
Reexamination and reconsideration of claims 1-3 and 5-30 is respectfully requested.

**Summary of The Office Action**

Claims 1-3, 9-12, 14-18 and 26 were rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis et al. (US 2002/0059489) (Davis).

Claims 5-8, 13, and 19-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 above, and further in view of Okigami (US 6,788,427) (Okigami).

Claims 27-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davis in view of Dutta (US 6,891,635) (Dutta).

**The Claims Patentably Distinguish Over the References**

**35 U.S.C. §102**

To establish a 35 U.S.C. §102 rejection it is axiomatic that a reference must teach every element of the claim. MPEP §2133 recites:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Here, Davis does not teach automatically identifying print options from characteristics of a print request sent from a client computer to a remote printer and/or print server. Davis is a pure parameter based system that uses traditional parameter passing techniques to read parameters from a print request. If parameters are not provided, they are not read and Davis takes no additional steps to automatically identify print options based on print request characteristics. Thus, none of the claims are anticipated by Davis.

**35 U.S.C. §103**

To establish a prima facie case of 35 U.S.C. §103 obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143.01 Second, there must be a reasonable expectation of success. MPEP §2143.02 Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.03 Additionally, the teaching or suggestion to make the claimed modification and/or combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where an invention is recreated from references using the Application as a blueprint.

Here, the first, second, and third criteria described in MPEP §2143 are not satisfied since (1) there is no suggestion or motivation to modify or combine the reference(s), (2) there is no reasonable expectation of success, and (3) the combination of references does not teach or suggest all the claim limitations.

Concerning the first criteria, no suggestion or motivation to modify or combine the references is given. For each §103 rejection, the Office Action makes a summary statement like that found on page 4:

It would have obvious to one skilled in the art at the time of the invention that the print options would have to be recognized by the remote printer in order for the print job to be outputted.

This summary sentence falls well below the standard required for identifying the motivation to modify or combine. An obviousness rejection must be supported by reasons why one of ordinary skill in the art would have been motivated to select the references and combine them. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2D 1453, 1459 (Fed. Cir. 1998). To follow the reasoning of a person of ordinary skill in the art, the skill level of that person must be ascertained and reported on. That is why the MPEP requires that the Office Action ascertain and describe the level of ordinary skill, so that objectivity can be maintained. MPEP §2141.03 reads:

The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

Here the Office Action neither ascertains nor reports on the level of ordinary skill in the art, which is an additional failing associated with criteria one.

Concerning criteria two, none of the references, alone or in combination, have any expectation of success because none of the references, alone or in combination, are capable of automatically identifying print options as claimed and described.

Concerning criteria three, none of the references, alone and/or in combination, teach automatically identifying print options from characteristics of a print request sent. For at least these reasons all the obviousness rejections are improper and should be withdrawn.

### **Hindsight Reconstruction**

The Office Action appears to engage in hindsight reconstruction. MPEP §2143 recites that “the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure”. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here no such teaching or suggestion is present and thus none is identified in the Office Action. Therefore, applicant will now comment on the propriety of combining the references in the manner performed in the Office Action. This appears to be hindsight reconstruction where the Office Action is using the Application as a blueprint to find parts of the claimed invention in unrelated references. Hindsight reconstruction has long been frowned upon:

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without **hindsight reconstruction** of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or **hindsight reconstruction** to supply deficiencies in its factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968) (emphases in original).

Additionally, MPEP §2143.01 (III) reads:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

The hindsight reconstruction engaged in by the Office Action is impermissible since nothing in the prior art or the references suggests the desirability of combining the references. Additionally, even though hindsight reconstruction has been engaged in, the Office Action still has not produced a reference or combination of references that teach every element of the claimed invention. For this additional reason none of the claims are obvious.

Each claim will now be examined to address the specific rejections provided in the Office Action:

Independent Claim 1

Claim 1 was previously amended to include the limitations of claim 4, and claim 4 was canceled by amendment. Claim 1 recites receiving from a client computing device a request to print an image on a remote printing device ... and applying print options identified by the request when printing the image, where the **print options are automatically identified** based at least in part on characteristics of the request. Claim 1 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis.

Davis was filed on November 13, 2001, which is after the July 12, 2001 filing date of the Application. While Davis claims priority to a provisional application filed on November 14, 2000, the Office Action does not provide the provisional application and thus Applicant can not determine whether the provisional application includes the material upon which the rejections are based. For this reason the rejection is improper as is the finality of the Office Action.

The Office Action equates “recognized by” and “automatically identified by”. This equating is erroneous. Davis is a pure parameter based system. In Davis, if “print options” are provided they are provided as parameters in a print request. To the extent that they are applied, which is not discussed in Davis, they are likely applied using traditional parameter passing techniques (e.g., pass by reference, pass by value) where values for options are simply read into the receiving process from the request. Thus, while their presence may be recognized and their values may be read from a request, this does not equal automatically identifying a print option based on a print request characteristic.

In one example, “automatically identifying”, as claimed and described, may include a receiver (e.g., print server) automatically selecting print options when parameters were not provided for those print options in a print request. Since no parameters were provided they could not be “recognized” at the receiver. As described and claimed, the print options may be selected based on characteristics of the print request, not parameters provided in a print request. The characteristics may include, for example, file name, file type, user print history, and so on. None of this is disclosed in Davis. Likewise none of this is obvious in light of Davis because Davis is purely a parameter based system. A couple of examples will explain this difference.

Consider a first print request in Davis:

Print filea.typea staple=yes, collate=no, sort=yes

This print request includes three print options: staple, collate, and sort. Values are provided for each of the three print options as parameters. Davis might apply these options after recognizing that they are available.

Consider a second print request in Davis:

Print fileb.typeb

This print request includes no print options. Thus, Davis would have no information concerning print options like stapling, collating, and/or sorting. Davis would not determine values for these print options based on characteristics of the print request like the file name “fileb” and/or the file type “typeb”. In the claimed invention, one or more print options would be identified based on characteristics of the print request. For example, the file name might indicate that stapling is desired while the file type might indicate that collating is desired. Davis is silent concerning any activity like this. Thus, Davis neither anticipates nor makes obvious the claimed subject matter because of this missing element.

Since claim 1 recites features not disclosed or suggested by Davis, claim 1 patentably distinguishes over Davis and also is not obvious. Accordingly, dependent claims 2-3 and 5-10 also patentably distinguish over the reference and are in condition for allowance.

#### Claim 2

Claim 2 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 2 depends from claim 1, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious. Additionally, claim 2 recites print options being identified by user-selection of a named print option configuration. Since the reference does not disclose identifying even one print option from print request characteristics, it is not surprising that the reference also does not disclose aggregating print options into a named print option configuration. For this additional reason this claim is not anticipated and is not obvious.

Claim 3

Claim 3 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 3 depends from claim 1, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious. Additionally, claim 3 recites the print options being automatically identified by a remote printing device. Since the reference does not disclose automatically identifying print options at all, it follows that the reference also does not disclose in which apparatus the identifying would occur. For this additional reason this claim is not anticipated and is not obvious.

Claim 5

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. As described above in connection with claim 1, The Office Action equates “recognized by” and “automatically identified by”. This equating is erroneous. Davis is a pure parameter based system. In Davis, “print options” are provided as parameters in a print request. To the extent that they are applied, if at all, they are likely applied using traditional parameter passing techniques. Thus, while the presence of a parameter may be recognized and a parameter value may be read from a request, this does not equal automatically identifying a print option based on a print request characteristic. Okigami does not remedy this deficiency.

Okigami basically describes how to prevent double printing at a remote printer and thus how to improve efficiency at a remote printer. Since it is printing files remotely, Okigami teaches a file name being transmitted as part of a print request. However, the file name is a simple parameter. The file name is not analyzed to automatically identify print options. Therefore, even in the combination of references there still is no automatic identification performed. Thus claim 5 is not obvious over Davis in further view of Okigami.

Claim 6

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 6 depends from claim 1, which has been shown to be not obvious. Thus this claim is similarly not obvious. Additionally, claim 6

recites one of the characteristics upon which automatic print option identification can be based as being a file size. Since neither of the references teaches any automatic identification, it is not surprising that neither reference teaches a characteristic like file size upon which the non-disclosed automatic identification could occur. For this additional reason claim 6 is not obvious over the references.

#### Claim 7

Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 7 depends from claim 1, which has been shown to be not obvious. Thus this claim is similarly not obvious. Additionally, claim 7 recites the automatic identification being carried out in connection with a set of rules that map characteristics to print options. Once again, since neither of the references teaches any automatic identification it is not surprising that neither reference teaches a set of rules being involved with the non-disclosed automatic identification. For this additional reason claim 7 is not obvious over the references.

This rejection does not even come close to satisfying the standard for a prima facie case for obviousness. Okigami is silent with respect to rules. When Okigami receives a print request, it compares information identifying the data requested to be printed to data describing what has already been printed to prevent double printing. This has nothing to do with automatically identifying print options (e.g., staple, collate, sort) from print request characteristics. Thus Okigami does not disclose rules for determining print options from print request characteristics. As mentioned above, the Office Action appears to engage in impermissible hindsight reconstruction. Here the reconstruction appears to be based on simple keyword based searching that yielded references having keywords found in claims, but which did not even come close to recreating the claimed subject matter. For this additional reason this claim is not obvious.

#### Claim 8

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 8 depends from claim 7, which has been shown to be not obvious. Thus this claim is similarly not obvious. Additionally, claim 8 recites the automatic identification being carried out in connection with a set of rules that map



characteristics to print options, where at least one of the rules is user-defined. Since neither reference teaches automatic identification and neither reference teaches rules based in the non-disclosed automatic identification, it follows that neither reference teaches one of the non-disclosed rules being user-defined. For this additional reason claim 8 is not obvious over the references.

#### Claim 9

Claim 9 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 9 depends from claim 1, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious. Additionally, claim 9 recites the print options being automatically identified by a print service associated with a remote printing device. Since the reference does not disclose automatically identifying print options at all, it follows that it also does not disclose a service in which the identifying would occur. For this additional reason this claim is not anticipated and is not obvious.

#### Claim 10

Claim 10 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 10 depends from claim 1, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious. Additionally, claim 10 recites a user being able to override the automatically identified print options. Since the reference does not disclose automatically identifying print options at all, it follows that the reference also does not disclose additional processing for overriding the print options. For this additional reason this claim is not anticipated and is not obvious.

#### Independent Claim 11

Claim 11 was previously amended to include the user-selected print options being automatically identified based at least in part on one or more characteristics of the request. Claim 11 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. As described above in connection with

claim 1, The Office Action equates “recognized by” and “automatically identified by”. This equating is erroneous. Davis is a pure parameter based system. In Davis, “print options” are provided as parameters in a print request. To the extent that parameters are applied, they are likely applied using traditional parameter passing techniques. Thus, while the presence of a parameter may be recognized and a parameter value may be read from a request, this does not equal automatically identifying a print option based on a print request characteristic.

Since claim 11 recites features not disclosed or suggested by the reference, claim 11 patentably distinguishes over the reference and is not obvious in light of the reference. Accordingly, dependent claim 12 also patentably distinguishes over the reference, is not obvious in light of the reference, and is in condition for allowance.

#### Claim 12

Claim 12 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 12 depends from claim 11, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious.

#### Independent Claim 13

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 13 was previously amended to include storing an indication of the print options selected in a sub-set for subsequent printing operations for a particular user. Davis does not disclose identifying print options so it follows that Davis also does not disclose storing the identified print options.

Davis is a pure parameter based system. In Davis, “print options” are provided as parameters in a print request. Thus, a set of print options for a remote printer is never displayed. Since no set of print options is ever displayed, no set of print options is ever stored. Okigami does not remedy this deficiency.

Okigami basically describes how to prevent double printing at a remote printer and thus how to improve efficiency at a remote printer. Since it is printing files remotely, Okigami teaches a file name being transmitted as part of a print request. Okigami may also disclose receiving parameterized print options. However, it does not disclose presenting those print

options to a user and thus also does not disclose storing the print options. Thus this claim is not obvious over Davis in further view of Okigami.

#### Independent Claim 14

Claim 14 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 14 was previously amended to include the print options being automatically identified based at least in part on a request characteristic(s). As described above in connection with claim 1, The Office Action equates “recognized by” and “automatically identified by”. This equating is erroneous. Davis is a pure parameter based system where “print options” may be provided as parameters in a print request. To the extent that they are applied they are likely applied using traditional parameter passing techniques. Thus, while the presence of a parameter may be recognized and a parameter value may be read from a request, this does not equal automatically identifying a print option based on a print request characteristic. Therefore, the reference fails to teach or suggest all the features of claim 14 and thus claim 14 patentably distinguishes over the reference and is not obvious in light of the reference.

#### Independent Claim 15

Claim 15 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 15 recites a method comprising receiving a print request identifying a document to be printed and automatically identifying, based at least in part on one or more characteristics of the print request, a set of print options to be used when printing the document. As described above in connection with claim 1, The Office Action erroneously equates “recognized by” and “automatically identified by”. Davis is a pure parameter based system where “print options” may be provided as parameters in a print request. To the extent that they are applied they are likely applied using traditional parameter passing techniques. Thus, while the presence of a parameter may be recognized and a parameter value may be read from a request, this does not equal automatically identifying a print option based on a print request characteristic. Therefore, the reference fails to teach or suggest all the features of claim 15 and thus claim 15 patentably distinguishes over the reference and is not obvious in light of the reference.

Accordingly claims 16-26 also patentably distinguish over the reference, are not obvious in light of the reference, and are in condition for allowance since they depend from claim 15.

Claim 16

Claim 16 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 16 depends from claim 15, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious.

Claim 17

Claim 17 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 17 depends from claim 15, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious.

Claim 18

Claim 18 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 18 depends from claim 15, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious.

Claim 19

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 19 depends from claim 15, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious. Additionally, claim 19 recites identifying by name a print option configuration that includes a set of print options. Neither reference teaches aggregating print options into a set of options that can be referred to collectively using a name. Thus, for this additional reason, claim 19 is not obvious.

Claim 20

Claim 20 was rejected “for the same reason as claim 5”. Thus, the same arguments made for claim 5 apply to claim 20 and claim 20 is not obvious.

Claim 21

Claim 21 was rejected “for the same reason as claim 6”. Thus, the same arguments made for claim 6 apply to claim 21 and claim 21 is not obvious.

Claim 22

Claim 22 was rejected “for the same reason as claim 7”. Thus, the same arguments made for claim 7 apply to claim 22 and claim 22 is not obvious.

Claim 23

Claim 23 was rejected “for the same reason as claim 8”. Thus, the same arguments made for claim 8 apply to claim 23 and claim 23 is not obvious.

Claim 24

Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 24 depends from claim 15, which has been shown to be not obvious. Thus this claim is similarly not obvious. Additionally, claim 24 recites analyzing previous print requests to identify patterns. Neither Davis nor Okigami disclose performing this type of analysis to identify patterns in characteristics of previous print requests. Okigami discloses analyzing a current print request to see if it is duplicative of an earlier print request. It discloses nothing even remotely close to analyzing previous print requests to detect patterns in print options associated with print requests. For this additional reason claim 24 is not obvious.

Claim 25

Claim 25 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 and further in view of Okigami. Claim 25 depends from claim 24, which has been shown to be not obvious. Thus this claim is similarly not obvious. Additionally, claim 25

recites automatically identifying print options based on both identified patterns and print request characteristics. Neither Davis nor Okigami disclose automatic identification of print options based on print request characteristics. Additionally, neither Davis nor Okigami disclose identifying patterns. Thus it is impossible for the combination of references to disclose automatic identification of print options based on both patterns and print request characteristics. For this additional reason claim 25 is not obvious.

#### Claim 26

Claim 26 was rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis. Claim 26 depends from claim 15, which has been shown to be not anticipated and not obvious. Thus this claim is similarly not anticipated and not obvious. Additionally, claim 26 recites a user being able to override the automatically identified print options. Since the reference does not disclose automatically identifying print options at all, it follows that it also does not disclose additional processing for overriding the print options. For this additional reason this claim is not anticipated and is not obvious.

#### Independent Claim 27

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis and further in view of Dutta. Neither Davis nor Dutta disclose an auto-select module configured to automatically select print options. As described above, Davis is a parameter based system that does not make print option identifications from print request characteristics. Dutta discloses a method for selecting advertisements based on other documents used by a web user who registered for a service. Dutta discloses one element of the system being a web server. Once again this rejection bears the hallmarks of keyword search based reconstruction. Like so many of that type of reconstruction it fails to establish a prima facie case for obviousness. In this case the hindsight reconstruction fails because the cobbled together references still do not teach every claimed element. Thus, claim 27 is not obvious over Davis in further view of Dutta.

Dutta discloses a document content type determiner that examines keywords in a document or document attributes to figure out what type of advertisement to present to a user. This has nothing to do with automatically identifying print options based on a print request.

Thus there can be no conceivable motivation to combine these references in the manner suggested. For this additional reason this claim is not obvious. Accordingly, claims 28-30 that depend from claim 27 also patentably distinguish over the references and are in condition for allowance.

#### Claim 28

Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis and further in view of Dutta. Claim 28 depends from claim 27, which has been shown to be not obvious. This claim is therefore similarly not obvious. Additionally, claim 28 recites the non-disclosed auto-select module including and using a set of rules that map characteristics to print options. Since neither of the references teaches automatic identification, it follows that neither reference teaches a set of rules being involved with the non-disclosed automatic identification. For this additional reason claim 28 is not obvious over the references.

Dutta discloses a document content type determiner that examines keywords in a document or document attributes to figure out what type of advertisement to present to a user. This has nothing to do with automatically identifying print options based on a print request. Thus there can be no conceivable motivation to combine these references in the manner suggested. For this additional reason this claim is not obvious.

#### Claim 29

Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis and further in view of Dutta. Claim 29 depends from claim 27, which has been shown to be not obvious. This claim is therefore similarly not obvious. Additionally, claim 29 recites automatically selecting print options. Neither Davis nor Dutta selects print options, thus this claim is not obvious for this additional reason.

Dutta discloses a document content type determiner that examines keywords in a document or document attributes to figure out what type of advertisement to present to a user. This has nothing to do with automatically identifying print options based on a print request. Thus there can be no conceivable motivation to combine these references in the manner suggested. For this additional reason this claim is not obvious.

Claim 30

Claim 30 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis and further in view of Dutta. Claim 30 depends from claim 27, which has been shown to be not obvious. This claim is therefore similarly not obvious. Additionally, claim 30 recites the auto-select module including a print history that stores characteristics of print requests and print options used in printing print requests. This print history is then used to automatically select print options. Since neither reference discloses selecting print options, it is not surprising that neither reference takes the additional step of selecting print options based on a print history. For this additional reason this claim is not obvious.

Dutta discloses a document content type determiner that examines keywords in a document or document attributes to figure out what type of advertisement to present to a user. This has nothing to do with automatically identifying print options based on a print request. Thus there can be no conceivable motivation to combine these references in the manner suggested. For this additional reason this claim is not obvious.



**Withdrawal of Final Rejection**

Applicant respectfully submits that the Final Rejection issued on the Application is improper based on MPEP §706.07(a) and should be withdrawn. MPEP 706.07(a) states “a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.” Independent claims 15 and 27 were not amended, yet they have now been rejected by newly cited art and the rejection has been made final. Thus, the finality of the Office Action is improper under MPEP 706.07(a) and should be withdrawn.

Additionally, MPEP §706.07 Final Rejection, states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. ... Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination.


Here, the Office Action has switched from one set of references to another in rejecting claims having substantially the same subject matter in successive actions. Furthermore, the new references to which the Office Action switched were deficient, not even coming close to disclosing each and every claimed element in the independent claims. This defeats the goal of reaching a clearly defined issue for an early termination. For this additional reason the finality of the Office Action should be withdrawn.

**Conclusion**

For the reasons set forth above, claims 1-3 and 5-30 patentably and unobviously distinguish over the references and are in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

DEC. 1, 2005

  
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